

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 4, 6 through 19 and 21 remain in this application. Claims 5 and 20 have been cancelled. No claims have been withdrawn or added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 1 through 7 of the Office Action

Claims 1 through 4, 6 through 7, 9 through 10, 13 through 15, 18, and 20 through 21 have been rejected under 35 U.S.C. §102(b) as being anticipated by Gaukel.

Claims 8, 16 and 17 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Gaukel in view of Miyashita.

Claim 1 requires, in part, "illuminating means for illuminating the interior compartment of the receptacle".

In the final Office Action, in the "Response to Arguments" portion in paragraph 3, it is contended that (emphasis added):

Applicant's arguments filed 08/16/2005 have been fully considered but they are not persuasive. In response to the applicant argument that Gaukel's lamp 82 is incapable of illuminating the interior of the cellular bag because of the location, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

However, it is submitted that 1) the recitation in claim 1 is not merely "a recitation of the intended use of the claimed invention", as alleged above, but the functional recitation of a proper §112, ¶6 "means plus function"

requirement, and that 2) the Gaukel patent does not disclose structure that is "capable of performing the intended use" or capable of performing the functionality of the "means plus function" recitation.

Turning first to the first point above, the subject requirement of claim 1 clearly is in means plus function form, and therefore the allegedly anticipatory structure must perform the stated function, using the structure disclosed in the patent application or a structure equivalent to the structure disclosed in the patent application.

The plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. Paragraph six does not state or even suggest that the PTO is exempt from this mandate...

Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

In re Donaldson Co., 29 USPQ 2d 1845, 1848-50 (Fed. Cir. 1994) (en bane)

It is submitted that the lamp 82 of Gaukel is not the structure or the equivalent of the structure disclosed in the present patent application.

Turning to the second point above, it is submitted that the lamp 82 of Gaukel is not capable of performing the claimed function. More specifically, the previous response pointed out several reasons why the lamp of the Gaukel patent is incapable of performing such a function, and the rejection of the final Office Action did not discuss any of these points in any detail, relying only upon a general assertion that the lamp of Gaukel is capable of "performing the intended use". However, it is again noted that the lamp 82 of Gaukel is located on the exterior of the "cellular bag" (30), and therefore is incapable of illuminating the interior of the cellular bag. In fact, the positioning of the lamp on the flap of the bag prevents any such

ability, as shown in Figure 3 and described in the detailed description of the Gaukel patent at col. 15, lines 40 through 61 (emphasis added):

FIG. 3 is a pictorial representation of the cellular bag 30 and associated external components and the connection to wristband 20. As seen in this figure, the major external identifiable components of cellular bag 30 comprise the waist or shoulder strap 31, the cellular antenna 35, and the GPS receiver antenna 33. The cable 68 is illustrated connecting the cellular bag 30 and the wristband 20 as discussed above. Cable 68 is operative to connect cellular bag 30 and wristband 20 providing communication and/or power therebetween. Lamp 82 is provided on the outside face of bag 30. Lamp 82 may be provided to alert the monitored person to an alert condition such as position violation as well as battery low condition or the like. Speaker 56 is provided to give an audio warning in addition to the visual warning provided by lamp 82. Also shown in the figure is the wrist strap 27 used to maintain the wristband 20 in position. Strap 27 also functions as a continuity strap used in conjunction with continuity detector 22 in order to provide an indication of removal or attempt at removal of the wristband 20. Finally, FIG. 3 illustrates one conventional battery charging apparatus 52 with a conventional rechargeable battery 38 installed therein.

However, should one be of the opinion that Figure 4 of the drawings of Gaukel show lamp 82 being capable of illuminating the interior of the cellular bag, it is submitted that Figure 4 merely shows the backside or inside portion of the lamp, which is flush mounted with respect to the exterior of the bag, and the housing of the lamp would naturally protrude slightly into the interior of the bag, but this does not disclose that the lamp is capable of illuminating the interior of the cellular bag of Gaukel. Looking to the description of Figure 4 in the Gaukel patent, it is noted that there is absolutely no mention of any ability to illuminate the interior of the bag. See Gaukel at col. 15, line 62 through col. 16, line 10:

FIG. 4 is a further enlargement of some of the internal components of cellular bag 30. Illustrated in this figure are the GPS receiver 32, the internal components of the cellular antenna 35, the cellular phone and modem communication apparatus 34, the connection cable 68, the central processing unit 36 and the GPS antenna 33. Also shown are the sources of electrical power for the "individual worn" components, namely batteries 38 and 58. Finally, the figure illustrates speaker 56 and lamp 82. Speaker 56 and lamp 82 are used to provide

an indication to the monitored person that he has exceeded compliance limits. In the "use arrest" situation, depending on the severity of the crime, the individual might be provided a certain limited time to correct the violation prior to action being taken. Speaker 56 and lamp 82 provide him with both a visual and audio indication that this "grace period" has begun.

It is noted that the lamp is described as providing a warning in concert with the speaker, and the speaker is clearly shown facing outwardly.

Furthermore, even if one were to take the position that the backside of the element labeled "82" in Figure 4 is capable of emitting light, it is submitted that its position on the flap makes it unsuitable for illuminating the interior of the cellular bag, as opening of the bag moves the element 82 out of proximity from the opening of the bag, and thus away from the interior of the bag, so that if any light were to be emitted, it would be directed upwardly away from the interior.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Gaukel and Miyashita set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claim 1. Further, claims 2 through 4 and 6 through 18, which depend from claim 1, also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §102(b) and §103(a) rejections of claims 1 through 4 and 6 through 8, and 10 through 18 is therefore respectfully requested.

Paragraph 8 of the Office Action

Paragraph 6 of the Office Action states that claim 19 would be allowable if written into independent form with the limitations of the base claim and any intervening claims.

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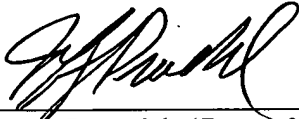
The above amendment incorporates the limitations of claim 1 into the recitation of added claim 19, and therefore claim 19 is believed to be in condition for allowance.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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